REMARKS

Claims 1-29 and 32 are pending. Claims 1 and 32 have been amended to clarify that the claims are directed to the optically active enantiomer as shown in formula (I). The Applicants expressly rebut any presumption that the Applicants have surrendered any equivalents under the doctrine of equivalents and expressly state that the claims, as amended, are intended to include and encompass the full scope of any equivalents as if the claims had been originally filed and not amended.

Support for the above amendments can be found in the specification at page 15, paragraph [0040] ("Compounds of formula (I) have one or more asymmetric carbon atoms and can exist in the form of optically pure enantiomers . . . optically active forms can be obtained for example by resolution of the racemates, by asymmetric synthesis or asymmetric chromatography . . .).

Double Patenting Rejection

In the Office Action, claims 1-29, and 32 were rejected under the judicially created doctrine of obviousness-type double patenting, as being unpatentable over claims 1-27 of U.S. Patent No. 6,642,389 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent. According to the Examiner, the compounds of the instantly claimed invention are "so closely related structurally to the homologous and/or analogous compounds of the reference as to be structurally obvious therefore in the absence of any unobvious or unexpected properties."

The Applicants wish to express their appreciation to Examiner Shameem for the interview courteously extended on December 20, 2004. During the interview, the rejection of claims 1-29 and 32 were discussed. The Applicants asserted that the claimed compounds (S enantiomers, wherein n=1) show surprising and unexpected properties over the racemates and other compounds disclosed in U.S. Patent No. 6,642,389 and accordingly, the obviousness-type double patenting rejection should be withdrawn. The Examiner then suggested that the Applicants present data showing the surprising or unexpected properties of the claimed compounds in a Declaration under 37 C.F.R. §1.132; or otherwise file a terminal disclaimer.

In response and in accordance with the Examiner's suggestion, the Applicants submit herewith a Declaration of Dr. Hans Peter Märki under 37 C.F.R. §1.132 which demonstrates the surprising and unexpected properties of the instantly claimed compounds (S enantiomers, wherein n=1) over the racemates, genera, and other compounds (wherein n=2 or more) disclosed in U.S. Patent No. 6,642,389.

For example, the optically pure (S) enantiomer wherein n=1 of the instantly claimed invention, (S)-2-Ethoxy-3-{4-[2-(4-isopropoxy-phenyl)-5-methyl-oxazol-4-ylmethoxy]-2-methyl-phenyl}-propionic acid, shows an IC_{50} value of 30 nmol/l compared to the corresponding racemate disclosed in U.S. Patent No. 6,642,389 which shows an IC_{50} value of 184 nmol/l with respect to alpha peroxisome proliferator activated receptor binding. Similarly, the same optically pure (S) enantiomer of the present invention, shows and EC_{50} value of 163 nmol/l compared to the corresponding racemate disclosed in U.S. Patent No. 6,642,389 which shows and EC_{50} value of 546 nmol/l with respect to the transactivation of alpha peroxisome proliferator activated receptors. Thus, the (S) enantiomers of the instantly claimed invention (wherein n=1 in formula I) show surprising and unexpected results over the corresponding racemates disclosed in U.S. Patent No. 6,642,389.

In another example, the optically pure (S) enantiomer wherein n=1 of the instantly claimed invention, (S)-2-Ethoxy-3-[2-methyl-4-(5-methyl-2-phenyl-oxazol-4-ylmethoxy)-phenyl]-propionic acid, shows an IC_{50} value of 87 nmol/l compared to the corresponding racemate disclosed in U.S. Patent No. 6,642,389 which shows an IC_{50} value of 234 nmol/l with respect to alpha peroxisome proliferator activated receptor binding. Similarly, the same optically pure (S) enantiomer, shows and EC_{50} value of 57 nmol/l compared to the corresponding racemate disclosed in U.S. Patent No. 6,642,389 which shows and EC_{50} value of 66 nmol/l with respect to the transactivation of alpha peroxisome proliferator activated receptors. Thus, the (S) enantiomers of the instantly claimed invention (wherein n=1 in formula I) show surprising and unexpected results over the corresponding racemates disclosed in U.S. Patent No. 6,642,389.

Accordingly, in view of the new claim amendments and the Declaration showing the surprising and improved activity of (S) enantiomers wherein n=1 of formula I over the racemates, genera, and other compounds disclosed and claimed in U.S. Patent No. 6,642,389, the Applicants respectfully request reconsideration and withdrawal of the above double patenting rejection. No fees are believed due with the filing of this Amendment other than the fee due for the Petition for Extension of Time. Nevertheless, the Office is hereby authorized to charge any additional fees, or credit any overpayment, to Deposit Account No. 08-2525.

Respectfully submitted,

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